



Attorney Docket No.: 27623U

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

KAUTZ

Serial No.: 10/591478

Group Art Unit: 1625

Filed: September 27, 2006

Examiner: DESAI, R.

For: **NOVEL ISOAMIDO-SUBSTITUTED HYDROXY-6-
PHENYLPHENANTHRIDINES**

RESPONSE TO RESTRICTION / ELECTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Official Action dated June 2, 2009. The one-month shortened statutory period for response is set to expire on July 2, 2009. Accordingly, this Response is timely filed within the time period set by the Examiner.

REMARKS

Claims 1-10, 12 and 15-17 are pending in this application. The Examiner has required restriction between the following groups of claims:

Group I: Claims 1-10 and 12, drawn to compounds of Formula I.

Group II: Claims 15-17, drawn to a method of treating an illness, airway disorder, PDE-mediated disorder using the compounds of Formula I.

PROVISIONAL ELECTION

Applicant provisionally elects Group I, directed to claims 1-10 and 12.

TRAVERSAL

Applicant respectfully traverses this restriction/election requirement because each of the "Groups" of claims that the Examiner alleges are "unrelated" share a special technical feature under PCT Rule 13.2. Accordingly, all of the presently pending claims possess unity of invention and restriction, therefore, is improper.

Unity of Invention between Groups I and II

Applicant respectfully submits that the claims of Group I and the claims of Group II possess "unity of invention" because they share a special technical feature as required by PCT Rule 13.2.

PCT Rule 13.2 states the following, in relevant part:

"[T]he requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression 'special technical features' shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art."

In the present application, the special technical feature that is shared between Groups I and II is the "compounds of Formula I", which does make a contribution over the prior art.

CONCLUSION

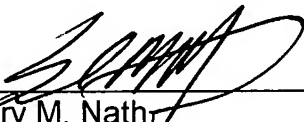
Based upon the above remarks, the presently claimed subject matter is believed to be novel and patentably distinguishable over the prior art of record. The Examiner is therefore respectfully requested to reconsider and withdraw the restriction / election requirement of the pending claims. Favorable action with an early allowance of the claims pending in this application is earnestly solicited.

The Examiner is welcomed to telephone the undersigned attorney if she has any questions or comments.

Date: July 1, 2009
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Respectfully submitted,
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